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**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
LEAP:127US

Re Application Of: **BONAVENTURA et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/733,628	12/11/2003	Arnel C. Lavarias	24041	2872	1669

Title: **MICROSCOPE STAGE CONTRASTING MEANS**

COMMISSIONER FOR PATENTS:

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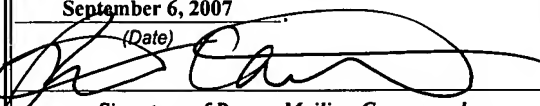
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Russell BONAVENTURA et al.

Application No.: 10/733,628

Filed: December 11, 2003

Examiner: Arnel C. LAVARIAS

Group Art Unit: 2872

Confirmation No. 1669

Attorney Docket No.: LEAP:127US

Customer No.: 24041

For: MICROSCOPE STAGE CONTRASTING MEANS

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Honorable Sir:

This Reply Brief is being submitted in response to the Examiner's Answer which was mailed by Examiner Lavarias on July 6, 2007 regarding the final rejection of Claims 1-6, 9-15 and 17-20, as set forth in the Final Office Action dated November 8, 2005. Appellants' Appeal Brief was timely filed originally on April 14, 2006, and subsequently on September 11, 2006 and March 27, 2007.

REAL PARTY IN INTEREST

Appellants courteously submit that the real party in interest has changed names since the original filing date of the instant appeal. The real party in interest is Leica Microsystems CMS GmbH, Assignee of the above application by assignment recorded in the Patent and Trademark Office at Reel 017921, Frame 0723.

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STATUS OF CLAIMS

The application originally contained 20 claims.

Claims 7, 8 and 16 have been canceled.

Claims 1-6, 9-15, and 17-20 stand as finally rejected.

Claims 1-6, 9-15 and 17-20 are the subject of this Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1-5 and 9-15 (which are separately patentable) are non-obvious under 35 USC § 103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 5,781,338 (*Kapitza et al.*)?
2. Whether Claim 6 is non-obvious under 35 U.S.C. § 103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 5,781,338 (*Kapitza et al.*), and in further view of U.S. Patent No. 4,436,385 (*Fischer et al.*)?
3. Whether claims 17-20 (which are separately patentable) are non-obvious under 35 U.S.C. § 103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 4,906,083 (*Sattler*)?

ARGUMENT

Regarding the rejections of Claims 1-6 and 9-15, the Examiner has anchored his argument upon the premise that “there is no requirement to show how teachings in various references are selected.” (See Pg. 9 of Examiner’s Answer). On the contrary, Appellants respectfully assert that the very foundation of a proper obviousness rejection is that there must be a suggestion or motivation to modify or combine references, and while the references do not have to explicitly suggest the combination, a suggestion or motivation must be shown. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The rejection parses words by delineating between a motivation to combine teachings from references and motivation to combine the references themselves. In either case the same holds true, a motivation or suggestion to combine must be found. The rejection picks and chooses elements from the cited references with no valid suggestion or motivation to combine or modify those references. In reply to Appellants’ argument against obviousness, the Examiner states in his Answer that Appellants have provided no evidentiary support to show why removal of the stage insert (holder clamp 20) from the upper stage (cell counter 10) as taught in *Douglas-Hamilton et al.* would not have been an obvious feat to one of ordinary skill in the art. Appellants respectfully assert that the Examiner has proceeded to shift the burden onto Appellants to produce evidence of non-obviousness before a *prima facie* case of obviousness has been made out by the Examiner. However, it is Appellants understanding that only after a *prima facie* case of obviousness has been made out by the Examiner, are Appellants required to show evidentiary support of non-obviousness. Therefore, as Examiner has failed to set forth a *prima facie* case of obviousness, Appellants are not required to show evidence of non-obviousness.

The “upper stage” of *Douglas-Hamilton et al.* that Examiner refers to is not an upper stage at all, but is an apparatus for measuring cell concentration in a biological sample. Moreover, any explanation of the Examiner’s motivation to combine is irrelevant since, even if combined, *Kapitza et al.* and *Douglas-Hamilton et al.* do not teach all the limitations of the claims. Namely, an upper stage with a recess and a non-transparent contrasting stage insert configured for removable complementarily receipt within the upper stage recess. Therefore,

prima facie obviousness of the claimed invention has not been established, since all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (CCPA 1974).

The Examiner alleges that “the rejected claims do not recite a microscope stage, nor do the recited claims recite any distinguishing structural features related to a microscope.” (*See* page 10 of Examiner’s Answer). Appellants respectfully disagree as Claims 1, 9 and 17 and all claims dependent therefrom explicitly recite that the claimed invention is a microscope stage in either the preamble or the body of the claim. Contrarily, the claims fail to recite an invention that is a cell counter or a lab instrument.

Moreover, the Examiner argues that preambular language is “not afforded significant patentable weight unless structurally distinguishable from the prior art.” (*See* page 11 Examiner’s Answer). Appellants respectfully assert that this is not the correct standard for determining the weight of language in the preamble. Contrarily, Appellants courteously submit, “[i]f a claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The phrase “microscope stage” gives the claims meanings. It is only from the phrase “microscope stage” that “the subject matter defined by the claims is comprised” as a microscope stage. *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). Therefore, it is Appellants’ position that the claims are related to a microscope stage, and that the preamble should be given significant patentable weight. Consequently, all the elements of Claims 1-6 and 9-15 are not taught by the combination of *Kapitza et al.* and *Douglas-Hamilton et al.*

The Examiner’s Answer states that it was appropriate to broadly interpret holder clamp 20 to read on the limitation of “a non-transparent contrasting stage insert comprising a second color,” and that Appellants’ arguments stating that this interpretation was overly broad are unfounded. (*See* page 13 Examiner’s Answer). The Examiner stated that Appellants’ argument, that the holder clamp 20 can not provide a background color for contrast against a specimen that

is being positioned on a stage, was an attempt to import limitations from the specification into the claims. However, Appellants' were not attempting to import limitations into the claims, but merely providing real life applications to highlight the advantages of the claimed invention (e.g., showing that a stage insert that is a different color than the upper stage provides the advantage of better location and positioning of specimens on a microscope stage). Additionally, this was done to highlight the lack of teaching in the cited references of "an upper stage comprising a first color" and "a non-transparent contrasting stage insert comprising a second color different from the first." This contrast in colors between the claimed insert and upper stage facilitates orienting specimens on the stage.

The Examiner contends that Claim 9 fails to recite a "non-transparent contrasting stage insert comprising a second color different from a first color of the upper stage." Interpreting Claim 9 which recites "an upper stage comprising a first color; and a non-transparent contrasting stage insert comprising a second color" The purposeful recitation of a first color and second color in a single claim is intended to portray that the first color and second color are two different colors. Appellants respectfully assert that there is no other reason to recite a first color and a second color, outside of trying to distinguish the two colors as different.

The Examiner cites *In re Keller* for support that obviousness can not be argued against by individually attacking references cited, where the rejections are based on combinations of references. However, Appellants respectfully disagree with this interpretation of *In re Keller*, and assert an obviousness rejection can be dismantled by showing that an individual reference is missing an element of a rejected claim that it is purported to teach. For example, Appellants have argued that *Statler* and *Douglas-Hamilton et al.* each fail to teach a non-transparent contrasting stage insert, so the obviousness rejection falls short due to both individual references being shown to miss the non-transparent contrasting stage insert. Obviousness rejections must include references that, in combination, teach or suggest all the claim limitations, and demonstrating that individual references, when combined, do not teach or suggest a claim limitation can be used to overcome an obviousness rejection.

In Appellants' brief a request is made for Judicial notice be taken to adopt a definition for transparent to mean "to allow light to travel through it." Thus, a *non-transparent* specimen holder would not allow light to travel through it. Contrarily, the Examiner's Answer contends that the term non-transparent should be defined as translucent and opaque, two terms that are incongruous. In fact, translucent and opaque are considered antonyms. The Examiner has asserted that Appellants' specification discloses a stage insert that can be translucent or non-transparent, and therefrom concluded that the disclosure of the two embodiments in a single specification gave the term a dual meaning, i.e., opaque and translucent. Appellants respectfully disagree as specifications often disclose more than what is claimed, and therefore describing both translucent and transparent stage inserts does not redefine the term non-transparent. Also, terms are afforded their ordinary understood meaning in the absence a contrary definition. Appellants' specification does not define the terms translucent and non-transparent in a manner that is in contradiction with standard definitions. The term non-transparent is defined according to the standard definition (i.e., does not transmit light) in Appellants' specification, and translucent is defined according to the standard definition as well (i.e., transmits light). Further support for the definition put forth by Appellants is the fact Claims 1, 2, 4, 9, 10, 11, 12, 13, 14, 15, 17-19 were amended to include the term non-transparent to distinguish the claimed invention over *Statler*, a device with a transparent element. Furthermore, the only claim that related to transparent features in the stage insert, Claim 16, was cancelled. Therefore, equating non-transparent to translucent is unsupported by the facts in this case or common knowledge among a person of ordinary skill in the art. Therefore, judicial notice should be taken to define transparent to mean "to allow light to travel through it."

In short, none of the cited references, alone or in combination, contain all the elements of the rejected claims. The references fail to teach both a microscope stage having a first color and a non-transparent stage insert disposed therein having a second, different color, and a microscope stage including a non-transparent insert having a first color and a specimen having a second, different color. The aforementioned, patentably distinct invention simply and elegantly

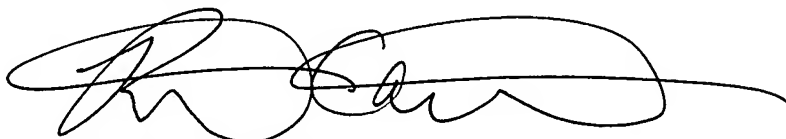
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addresses the problem described in Appellants' paragraph [0002], i.e., the difficulty of orienting specimens when placing them on a conventional, flat black microscope stage.

CONCLUSION

In view of the foregoing, Appellants respectfully assert that the pending claims are patentable over the cited references. Reversal of the rejection in the Final Office Action is therefore respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. C. Atkinson', with a long horizontal flourish extending to the right.

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